

REMARKS

Initially, the Examiner is respectfully requested to acknowledge Applicants' claim for foreign priority and receipt of the certified copy of the priority document.

Also, the Examiner is respectfully requested to return an initialed copy of the Form PTO/SB/08 filed with Applicants' Disclosure Statement of March 25, 2010.

In the present Amendment, claim 14 has been amended to correct formula "(I)" to formula "(I-3-4)" of claim 23. Claims 15-18 have been cancelled without prejudice or disclaimer. Claim 26 has been amended to incorporate a part of the subject matter of claim 29. Claims 27-29 have been cancelled in view of the amendment to claim 26. No new matter has been added, and entry of the Amendment is respectfully requested.

Upon entry of the Amendment, claims 1-14, 19-21 and 23-26 will be pending, of which claims 1-13 and 19-21 are withdrawn from consideration.

Applicants note with appreciation that claims 14 and 23-25 are allowed.

Response to § 112 Rejection

At page 4 of the Action, claims 15-18 and 26-29 are rejected under 35 U.S.C. § 112, first paragraph, because, per the Examiner, the specification, while being enabling for having an affinity to MBR and treating psychological stress, does not reasonably provide enablement for treating any diseases caused by stress recited in the present claims.

Claims 15-18 and 27-29 have been cancelled, leaving only claim 26 subject to this rejection.

Applicants submit that this rejection should be withdrawn because claim 26 as amended is enabled.

The test of enablement is whether persons skilled in the art, based on the description in the specification coupled with the knowledge of those skilled in the art, could make and use the claimed invention without undue experimentation. The fact that some experimentation is required to practice the claimed invention does not defeat enablement, provided that the experimentation involved is not undue. *See* MPEP §§ 2164 and 2164.01.

In the present case, claim 26 as amended relates to a method for treatment for irritable bowel syndrome in a mammal, which comprises administering an effective amount of the compound represented by formula (I-3-4), or a salt thereof, to a mammal in need thereof.

The present specification discloses how to use the compounds and compositions to treat diseases caused by stress and that the compounds, in combination with other pharmaceutical preparations, can be administered to the entire human body topically, orally or parenterally. The dosage of the compounds to be administered depends on age, body weight, symptom, therapeutic effect, etc. *See*, pages 42-51 of the specification.

Further, the specification teaches that the presently claimed compounds have an affinity for mitochondrial benzodiazepine receptors (MBR), which is useful for prevention and/or treatment for diseases caused by stress and that MBR antagonist can inhibit steroid production in the brain. The specification discloses that the affinity of the present claimed compounds to the MBR was determined using rat brain membrane. Specifically, the results of the receptor binding experiment show that the presently claimed compounds had a high affinity to MBR. Furthermore, the anti-stress effects on Wistar rats were evaluated. This is disclosed in the present specification as Biological Example 2 (using the nine compounds in Example 17). The results of the evaluation show that the compound of the presently claimed invention had anti-stress effects on the laboratory experimental mice.

Still further, the fact that a compound having high affinity to MBR shows anti-stress effect is described in US 2005/0009812 A. Additionally, animal models used in the evaluation of anti-stress effects reflects effectiveness for irritable bowel syndrome (IBS) as described in publications such as *Brain Res.*, 641, 21-28 (1994) and *Jpn. J. Pharmacol.* 77, 211-217 (1998), which were submitted with the Amendment under 37 C.F.R. § 1.111 filed August 19, 2009. Thus, a person skilled in the art would know that the present compounds, having high affinity to MBR, are useful for stress related disease such as IBS and the like.

Accordingly, claim 26 as amended is enabled.

In view of the above, reconsideration and withdrawal of the §112 rejection are respectfully requested.

Response to Double Patenting Rejection

At page 3 of the Action, the Examiner has maintained the non-statutory obviousness-type double patenting rejection of claims 23-25 and 14-18 based on claims 1-29 of co-pending Application No. 11/722,623 (the '623 application).

However, as noted above, the Examiner indicated that claims 14 and 23-25 are allowed.

Furthermore, as discussed above, Applicants believe claim 26 of the instant application is allowable. Because the '623 application has a later effective filing date (December 21, 2005) than the instant application (June 22, 2004), withdrawal of the provisional obviousness type double patenting rejection is respectfully requested, should the above claims of the instant application are found allowable. See, MPEP 804.I.(B)(1).

Allowance is respectfully requested. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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